



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,793	01/07/2004	Mario Rosario Carlone JR.	P06276US01-PHI 1334	5128
27142	7590	07/18/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. ATTN: PIONEER HI-BRED 801 GRAND AVENUE, SUITE 3200 DES MOINES, IA 50309-2721			FOX, DAVID T	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,793

Applicant(s)

CARLONE ET AL.

Examiner

David T. Fox

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20 April 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's Terminal Disclaimer of 20 April 2005 has obviated double patenting rejection of record. Applicant's remarks of 20 April 2005 have overcome the rejections of claims 7-10 under 35 USC 112, first paragraph, regarding the presence of a single cell from an inbred parent. However, these claims remain rejected under 35 USC 112, first paragraph, regarding the issue of F1 hybrids themselves, as stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on pages 3-4 of the last Office action, regarding F1 hybrids.

Claims 1-10 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on pages 5-7 of the last Office action regarding F1 hybrids.

Claims 1-10 remain free of the prior art, for the reasons stated in the last Office action on page 7.

No claim is allowed.

Applicant's arguments filed 20 April 2005, insofar as they pertain to the rejections above, have been fully considered but they are not persuasive.

Applicant urges that the written description rejection is improper, given the conserved sequence of the exemplified inbred parent which comprises one-half of all of the hybrids' genomes, the deposit of the plant material per *Enzo*, and the disclosure of many hybrids produced with the exemplified inbred as one parent.

The Examiner maintains that there is no correlation between the conserved sequence and function, as required by *Lilly* cited previously, since each hybrid would have a completely different set of morphological traits, influenced by the genetic makeup of the second inbred parent.

Regarding *Enzo*, the Examiner maintains that the court only decided that deposit of an organism may provide adequate written description of the same organism. The court in *Enzo* remanded the case to the lower court for decision on whether the deposit of a single microbial strain provided an adequate written description of mutants of that strain. In the instant case, the deposited strain does not differ from the claimed strain by only one or a few mutant genes. Thus, it is even less likely that the court in *Enzo* would deem F1 hybrids to be adequately described by deposit of one inbred parent which potentially differs from the second parent at every genetic locus.

Regarding the disclosure of several hybrids, the Examiner maintains that no correlation has been demonstrated between structure (gene sequence of one parent inbred) and function (the morphological complement of each divergent F1 hybrid descended from a different second parent).

Art Unit: 1638

Applicant urges that the enablement rejection is improper, given the inapplicability of the references cited by the Examiner to support his position.

The Examiner maintains that each reference teaches the general unpredictability inherent in corn breeding, wherein said teachings would indeed be applicable to the production of F1 hybrids by crossing a single inbred first parent with a multitude of non-exemplified second parents.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is 571-272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

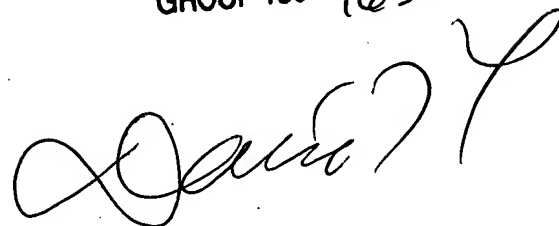
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1638

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 11, 2005

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

A handwritten signature in cursive script, appearing to read "David T. Fox", written over the printed name and title.